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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,010	10/15/2001	Yoshio Uchida	Q66667	9598

7590

06/20/2003

SUGHRUE MION ZINN MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

BOS, STEVEN J

ART UNIT

PAPER NUMBER

1754

DATE MAILED: 06/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,010

Applicant(s)

UCHIDA, YOSHIO

Examiner

Steven Bos

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1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 1,3 are objected to because of the following informalities: In claim 1, it appears that "tow" was intended to be --two--. In claim 3, the quotations are superfluous. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,4,5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "at least tow kinds of metal salts" is indefinite as to what is meant by "kinds of metal salts"; ie. what is considered to be a kind of metal salt?

In claim 1, "two kinds of metals" is indefinite as to what is meant by "kinds of metals"; ie. what is considered to be a kind of metal?

In claim 4, "at least two kinds of metal atoms" is indefinite as to what is meant by "kinds of metal atoms"; ie. what is considered to be a kind of metal atom?

In claim 5, it is indefinite as to how a "complex metal oxide" can be formed in claim 1 when the same metal is used in each metal salt as claimed in claim 5. Complex metal oxide is taken to mean an oxide having 2 or more different metal elements therein.

In claim 5, "are made of a same metal" is indefinite as to what is meant by this language.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3,6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saegusa '505.

Saegusa suggests the instantly claimed process but may differ in that heating to a temperature at which transition to a complex metal oxide occurs is not stated. See cols. 3-5,7, examples 1-5.

However Saegusa teaches calcining, ie. heating, at the same temperatures instantly claimed to form the same perovskite titanates, ie. complex metal oxide, instantly claimed thus the instantly claimed heating to the complex metal oxide transition temperature would appear to be suggested.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping

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portion of the range disclosed by the references because overlapping ranges have been held to be a prima facie case of obviousness, In re Malagari, 182 USPQ 549.

Claims 1-3,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohri '480.

Mohri suggests the instantly claimed process but may differ in that heating to a temperature at which transition to a complex metal oxide occurs is not stated. See col. 4.6 and the claims.

However Mohri teaches calcining, ie. heating, at the same temperatures instantly claimed to form the same perovskite titanates, ie. complex metal oxide, instantly claimed thus the instantly claimed heating to the complex metal oxide transition temperature would appear to be suggested.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the references because overlapping ranges have been held to be a prima facie case of obviousness, In re Malagari, 182 USPQ 549.

Claims 1,7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1065693.

EP '693 suggests the instantly claimed process but may differ in that heating to a temperature at which transition to a complex metal oxide occurs is not stated. See col. Paragraphs 16-22, example 1.

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However EP '693 teaches calcining, ie. heating, at the same temperatures. instantly claimed to form the same perovskite titanates, ie. complex metal oxide, instantly claimed thus the instantly claimed heating to the complex metal oxide transition temperature would appear to be suggested.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the references because overlapping ranges have been held to be a prima facie case of obviousness, In re Malagari, 182 USPQ 549.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Bos whose telephone number is 703-308-2537. The examiner can normally be reached on increased flextime program.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 703-308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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A handwritten signature in black ink, appearing to read 'SJB' with a stylized flourish at the end.

Steven Bos
Primary Examiner
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sjb
June 17, 2003